

1 REMARKS

2 Status of the Claims

3 Claims 1-14, 16-18, 22-24, 26, and 77-80 are now pending in the present application, Claims 71-76
4 having been canceled in the present amendment, Claims 15, 19-21, and 25 having been previously canceled,
5 Claims 27-70 having been previously canceled as non-elected in response to a previous restriction
6 requirement, and Claims 78-80 having been added in the present amendment. Claims 1, 3, 4, 5, 11, 12,
7 13, 16, and 17 have been amended to address grammatical issues, indefiniteness issues, and dependency
8 issues.

9 Oath/Declaration

10 The Examiner asserts that the oath or declaration is defective, and a new oath or declaration must be
11 filed. The Examiner's reasoning is based on MPEP 602.01 and 602.02. The Examiner notes that because
12 the application is now a continuation-in-part application (due to the amendment claiming priority to an
13 earlier filed application), a new oath or declaration is required.

14 Applicants respectfully disagree that a new oath or declaration is required. 37 C.F.R. 1.63(e)
15 specifically states: "*A newly executed oath or declaration must be filed in any continuation-in-part*
16 *application, which application may name all, more, or fewer than all of the inventors named in the prior*
17 *application.*" This requirement contrasts with the filing of a divisional or continuation application, which
18 may use the oath or declaration of the original parent application. The earlier filed application (i.e., the
19 parent) is Application No. 09/496,999 (hereafter referred to as the '999 application). A declaration was
20 properly filed in the '999 application by Thomas Schwalbe, Klaus Golbig, Michael Hohmann, Petra Georg,
21 Andreas Oberbeck, Bernd Dittmann, Jiri Stastna, and Sebastian Oberbeck. The present application, which
22 is a continuation-in-part application based on the '999 application, was filed with *a newly executed*
23 *declaration* (relative to the declaration filed in the '999 application), and the new declaration was executed
24 by Thomas Schwalbe, Sebastian Oberbeck, Klaus Golbig, Michael Hohmann, and Andreas Oberbeck.
25 Clearly, the declaration originally filed in the present application is different than the declaration filed in the
26 parent application, and applicants are not simply attempting to rely upon the same declaration filed in the
27 '999 application. Thus, the requirement set forth in 37 C.F.R. 1.63(e) has already been met.

28 A review of MPEP 602 provides no indication as to why a new oath or declaration ought to be
29 required, where the original declaration filed with this CIP clearly satisfies the requirements of
30 37 C.F.R. 1.63(e). None of the elements required of an oath or declaration as outlined in MPEP 602 and

1 37 C.F.R. 1.63 are missing from the declaration filed in the present application. The amendment to the
2 claim of priority to an earlier filed U.S. patent application does not appear to affect any of the required
3 elements of an oath or declaration. Therefore, it is unclear what statutory or other basis exists for requiring
4 applicants to execute and submit a new declaration. Amendments to the claims, drawings and specification
5 are regularly made to patent applications during prosecution, without triggering a requirement for the
6 submission of a new oath or declaration. Similarly, applicants' previous amendment to the specification to
7 claim priority in an earlier filed application does not appear to require the submission of a new oath or
8 declaration beyond that submitted with the present application as it was originally filed. The required
9 elements of an oath or declaration are listed in 37 CFR 1.63, and the declaration filed with the present
10 application appears to include each of these elements.

11 Amendment to the Specification

12 The Examiner has noted that the new paragraphs which the Preliminary Amendment filed on
13 May 4, 2005 indicates should be inserted "On Page 25, before the paragraph and heading beginning at
14 line 29, at page 25, line 29" cannot be added, because there is no paragraph or heading at that location.
15 Applicants' attorney apologizes for the error in indicating the insertion point.

16 The correct insertion point is on page 7, before the paragraph and heading titled "Brief Description
17 of the Drawing Figures," beginning at line 29. Appropriate correction has been made in the present
18 amendment.

19 Claims Rejected under 35 U.S.C. § 112

20 The Examiner has rejected Claims 1-14, 16-18, 22-24, and 71-75 under 35 U.S.C. § 112, second
21 paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter
22 which applicants regard as the invention.

23 The Examiner has correctly noted that independent Claims 1, 71, and 75 fail to provide proper
24 antecedent basis for the term "apparatus." In Claim 1, the term "the apparatus" has been replaced by the
25 term "said reactor." Claims 71-75 have been canceled.

26 The above noted amendments address the Examiner's rejections under 35 U.S.C. § 112, second
27 paragraph, and these rejections should now be withdrawn.

28 Claims Rejected under the Judicially Created Doctrine of Obviousness-Type Double Patenting

29 The Examiner rejected Claims 1-3, 5-7, 9-11, 13, 14, 16, 17, and 71-76 under the judicially created
30 doctrine of obviousness-type double patenting as being unpatentable over Claims 1-43 and 46-55 of

1 commonly assigned U.S. Patent No. 6,537,506 in view of Bard (U.S. Patent No. 5,580,523) and
2 Agrafiotis et al. (U.S. Patent No. 5,463,564). The Examiner notes that a timely filed terminal disclaimer in
3 compliance with 37 C.F.R. § 1.321(c) may be used to overcome non-statutory double patenting, provided
4 the conflicting patent is shown to be commonly owned.

5 While applicants recognize that the claims rejected under the judicially created doctrine of
6 obviousness-type double patenting can be overcome by submitting a timely filed terminal disclaimer,
7 applicants instead have elected to address this rejection by amending the claim structure so that the claims
8 are not obvious in view of applicants' previously issued patent in combination with the other cited art.

9 Claim 1 has been amended to incorporate the subject matter of Claim 4, to which the Examiner has
10 objected (as noted in the following section of this response). Thus Claim 1, and each claim dependent
11 thereon (i.e., Claims 2 and 11), are patentably distinguishable over Claims 1-43 and 46-55 of commonly
12 assigned U.S. Patent No. 6,537,506 in view of Bard and Agrafiotis.

13 Claims 3, 4, 12, 13, and 16 have been amended to depend on allowed Claim 77. Claim 17 has been
14 amended to depend from Claim 16. Thus, Claims 3-10, 12-14, 16-18, 22-24, and 26 now ultimately depend
15 from Claim 77, and are therefore patentable for at least the same reasons. Claims 71-76 have been canceled,
16 thereby obviating their rejection. The above noted amendments address the Examiner's rejections under the
17 judicially created doctrine of obviousness-type double patenting, and these rejections should now be
18 withdrawn.

19 Claims to which the Examiner Has Objected/Patentability of Newly Added Claims

20 The Examiner has objected to Claims 4, 8, 12, 18, 22-24, and 26 as being dependent upon a
21 rejected base claim, but has indicated that they would be allowable if rewritten in independent form
22 to include all of the limitations of the base claim and intervening claims.

23 As explained above, Claim 1 has been amended to incorporate the subject matter of Claim 4,
24 effectively rewriting Claim 4 in independent form. The dependency of Claim 4 was then changed,
25 such that Claim 4 (as well as Claims 18, 22-24 and 26) now depends on Claim 77, which has been
26 allowed.

27 New Claim 78 corresponds to Claim 8, rewritten in independent form. The dependency of
28 Claim 8 has been changed (by amending Claim 5), such that Claim 8 now ultimately depends on
29 Claim 77, which has been allowed.

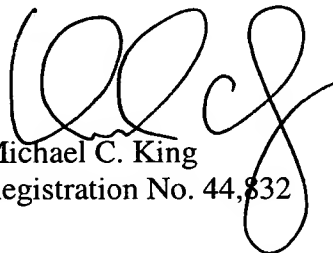
30 New Claim 79 corresponds to Claim 12 rewritten in independent form. The dependency of

1 Claim 12 has been changed, such that Claim 12 now ultimately depends on Claim 77, which has been
2 allowed.

3 New Claim 80 corresponds to Claim 77 rewritten in independent form (but with fewer
4 elements recited with respect to the replaceable reactor and with a slight reordering of the elements).
5 Applicants believe that Claims 77 and 80 patentably distinguish over the cited art by virtue of reciting
6 a frame comprising "*a plurality of plates, at least one of which is fixed in position, and at least one of*
7 *which is moveable, the at least one of the plurality of plates that is moveable enabling the replaceable*
8 *reactor to be removed from the mounting frame.*" This configuration is schematically illustrated in
9 FIGURES 10 and 11 of the application as filed, and is described in detail in the portion of the
10 specification (as filed) corresponding to FIGURES 10 and 11. The cited art does not teach or suggest
11 an equivalent frame; thus, the combination of references suggested by the Examiner does not achieve
12 an equivalent of applicants' recitation in Claims 77 and 80.

13 In consideration of the amendments and remarks set forth above, it is apparent that all claims in the
14 present invention define a novel and non-obvious invention. Therefore, the Examiner is requested to pass
15 this case to issue at an early date. In the event that any further questions remain, the Examiner is requested
16 to telephone applicants' attorney at the number listed below.

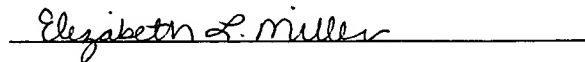
17 Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope
as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria, VA
22313-1450, on October 20, 2005.

Date: October 20, 2005



Enclosure:
Supplemental IDS